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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,955	10/15/2003	Mitch Fredrick Singer	113748-4836US	8821
27189 7590 01/31/2008 PROCOPIO, CORY, HARGREAVES & SAVITCH LLP 530 B STREET SUITE 2100 SAN DIEGO, CA 92101			EXAMINER MURDOUGH, JOSHUA A	
			ART UNIT 3621	PAPER NUMBER
			NOTIFICATION DATE 01/31/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@procopio.com
PTONotifications@procopio.com

Office Action Summary

Application No.

10/686,955

Applicant(s)

SINGER ET AL.

Examiner

JOSHUA MURDOUGH

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 39 is/are pending in the application.
- 4a) Of the above claim(s) 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :1/12/2004, 6/25/2004, 10/25/2004, 7/24/2007, 10/31/2007, 12/3/2007.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Invention I in the reply filed on 9 January 2008 is acknowledged.
2. Claims 21-38 and 40-70 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9 January 2008.
3. Applicant's election without traverse of Species I1 in the reply filed on 9 January 2008 is acknowledged.
4. Claim 39 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9 January 2008.

Information Disclosure Statement

5. Documents within still pending applications lack a definitive date of publication and therefore have not been considered. This has been indicated on the 1449 sheets by striking through the references. All references not struck through have been considered.

Claim Rejections - 35 USC § 112 2nd Paragraph

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claims 1- 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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- a. In line 6 of claim 1, the phrase “said content stored on said server” could be reasonably interpreted to refer to the previously mentioned content that has already been shown to be on the server, which lacks antecedent basis as it has not been stated that the content has been stored on the server. It could also be interpreted to mean the previously mentioned (said) content, which is stored on the previously mentioned (said) server. The Examiner believes the latter to be the intended interpretation and has considered the claim to read “said content, which is stored on said server” when evaluating it on its merits.
 - b. Claims 2-20 depend from claim 1 and therefore are rejected under the same basis.
 - c. In claim 15, the language is confusing to the reader. Please revise for clarification. For example, Applicants cite encryption as one form of disabling the content (specification, pages 5-6, lines 30-7), therefore, it is not clearly understood why a version that is not disabled would have to be decrypted. Also if the locked content data is encrypted, thus needing decryption, is it not disabled?
8. Claims 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: revoking the authorization of the one or more devices. Claim 10 shows that one or more devices have been revoked, but the actual revocation step(s) is/are missing.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-10 and 13-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Chase JR (2003/0187801) hereafter "Chase".

11. As to claim 1, Chase shows:

A method of binding content to a hub network, comprising:

receiving a request to bind a discrete version of content (Figure 1, element 12p) to a

hub network (Figure 1, element 10), including a server (Figure 1, element 22)

and a client (Figure 1, element 14) as members of said hub network (the user

requests a license [0018] that binds the discrete content and the license to a "black

box" [0017]. Therefore, the request is also a request to bind the content.),

wherein said discrete version includes discrete locked content data [0016];

disabling said discrete version (encrypting it would make it disabled until the correct

key is applied);

creating a source version (the server 22 is the distribution source [0118] , therefore

the version on the server would be the source version) of said content stored on

said server, wherein said source version includes source locked content data

[0011]; and

creating a root license stored on said server (since the license is encrypted with the

private root key, it is understood to be a root license [0213]),

wherein said root license is bound to said hub network (the private root key is unique to the server [0213], therefore the license cannot be read outside of the network).

12. As to claim 2, Chase further shows:

receiving said discrete version stored on compliant media [0080];

wherein compliant media is readable and writable electronic storage media [0080].

13. As to claim 3, chase further shows:

said discrete version has a corresponding discrete license (Figure 8, element 16).

14. As to claim 4, Chase further shows:

disabling said discrete version includes disabling said discrete license (Abstract).

15. As to claim 5, Chase further shows:

creating said root license includes creating said root license according to said discrete license [0214]-[0220].

16. As to claim 6, Chase further shows:

said server will decrypt said discrete locked content data after disabling said discrete version upon request [0016].

17. As to claim 7, Chase further shows:

said root license indicates said server has root responsibility for said source version (Through the root license, the root server delegates its authority to other servers [0221]).

18. As to claim 8, Chase further shows:

creating a copy of said discrete locked content data [0080]; and

storing said copy as said source locked content data [0080].

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19. As to claim 9, Chase further shows:

creating bound licensing authority data according to discrete licensing authority data [0221];

wherein said discrete licensing authority data corresponds to said discrete version

(Figure 1, element 12p) and said discrete licensing authority data indicates an

external server is an external licensing authority (Figure 1, element 24), said

bound licensing authority data corresponds to said source version and said bound

licensing authority data indicates said root license is a local licensing authority

and said external server is an external licensing authority [0221].

20. As to claim 10, chase further shows:

said discrete version has a corresponding revocation list of one or more devices for

which authorization to participate in a hub network has been revoked [0279].

21. As to claim 13 Chase further shows:

creating a revocation list corresponding to said source version by creating a copy of

said revocation list corresponding to said discrete version [0306].

22. As to claim 14, Chase further shows:

said server and said client are both compliant devices, a compliant device will not

decrypt locked content data without a license that is bound to a hub network of

which the compliant device is a member (This is inherently true, as the content is

locked/encrypted by a key that binds it to the DRM system. [0017]-[0018]).

23. As to claim 15, it is unclear as to what applicant is claiming, as cited above in the 112

2nd rejection. Therefore, this claim is rejected under the same basis as claim 14.

24. As to claim 16, Chase further shows:

creating a source key by copying a discrete key (same key for both, therefore it must have been copied [0212]);

wherein said discrete key is for decrypting said discrete locked content data, and said source key is for decrypting said source locked content data [212].

25. As to claim 17, Chase further shows:

said discrete locked content data is encrypted using a content encryption technique,

said source locked content data is encrypted using said content encryption

technique, said discrete key is encrypted using a hub network encryption

technique that is different from said content encryption technique, and said source

key is encrypted using said hub network encryption technique [0011].

26. As to claim 18, Chase further shows:

said server stores a hub network key for decrypting data encrypted using said hub

network encryption technique [0012]-[0013].

27. As to claim 19, Chase further shows:

said hub network encryption technique is different from said content encryption

technique because said hub network encryption technique uses a different key for

encrypting data than the key that said content encryption technique uses for

encrypting data [0011].

28. As to claim 20, Chase further shows:

said root license is encrypted using said hub network encryption technique [0213].

Claim Rejections - 35 USC § 103

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

30. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chase.

31. As to claim 11, Chase further shows a check for the revocation of user's license [0306].

32. Chase does not show the check being performed prior to accepting content to the server.

However, the steps would be the same as those performed for the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Chase to include the check prior to allowing content to be uploaded in order to prevent the repeated uploading of content with viruses to the server.

33. As to claim 12, Chase further shows the updating of the revocation list [308] and a check for the revocation of user's license [0306].

34. Chase does not show these concepts in relation to the server. However, the steps would be the same as those performed for the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Chase to include the check prior to allowing content to be uploaded in order to prevent the repeated uploading of content with viruses to the server.

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Conclusion

35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ginter (5,892,900) also shows the distribution of digital content wherein the content is encrypted and the binding of channels for distribution.

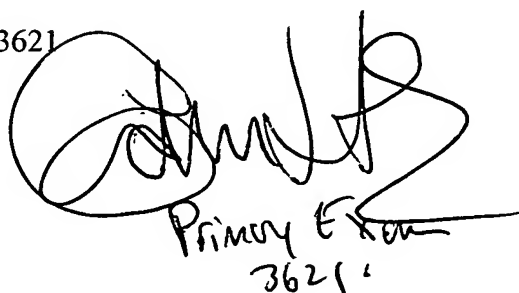
36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

37. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

38. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. M./

Examiner, Art Unit 3621



Primary Examiner
3621